

REMARKS

Summary of the Amendment

Claims 1-38 are pending with claims 1, 37 and 38 being in independent form and with claims 35 and 36 being withdrawn by the Examiner on the basis of a restriction requirement.

Summary of the Official Action

In the instant Office Action, the Examiner neglected to fully acknowledge Applicant's claim to foreign priority by neglecting to indicate on the form PTOL-326 that the certified copy of the priority document has been received. The Examiner also required restriction and indicated that claims 35 and 36 were withdrawn from examination. Additionally, the Examiner objected to claim 1 on the basis of an asserted informality. Finally, the Examiner rejected claims 1-34, 37 and 38 over the art of record. By the present remarks, Applicant submits that the rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Telephone Interview of March 21, 2006

Applicant's representative contacted the Examiner by telephone to request a personal interview with the Examiner in an attempt to resolve the outstanding issues in this application. The Examiner explained that it was his policy not to grant Interviews unless it was "absolutely necessary". The Examiner did not explain what he meant by such a

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requirement and explained that, even if he granted an interview, he was unlikely to give serious consideration to Applicant's arguments. He noted, in particular, that, in his experience, interviews which merely discussed the prior art rejections without proposing claim amendments were not productive.

Applicant's representative regrets that the Examiner has chosen to disregard the current USPTO policy of granting such interviews in order to advance prosecution, and sincerely hopes that the Examiner will reconsider such a policy in the future.

Status of the Certified Priority Document

The Examiner has acknowledged Applicant's claim to foreign priority on the form PTOL-326. However, he has neglected to indicate whether the required certified copy of the priority document has been received.

Applicant filed a certified copy of the priority document on February 13, 2004 and requests that the Examiner check box 12a1 on the form PTOL-326 in the next Official Action confirming receipt of the certified copy.

Accordingly, Applicant respectfully requests that the Examiner indicate such acknowledgment on form PTOL-326 in the next office action.

Restriction Requirement

Applicant acknowledges the restriction requirement asserted in the instant Office Action and the provisional election, with traverse, of claims 1-34, 37 and 38. Applicant submits that the basis for restriction is improper at least because claims 35 and 36 depend

from elected claims.

Applicant notes, in particular, that the Examiner is not correct that there is no generic or linking claim because withdrawn claims 35 and 36 depend from claim 1. Nor is the Examiner correct in asserting that claims 35 and 36 are actually independent claims. Such an argument is betrayed by the actual claim language, and is entirely without support in the MPEP or any USPTO rule.

Accordingly, the basis of restriction is entirely improper and should be withdrawn. Furthermore, Applicant requests that the withdrawn claims be rejoined if and when generic independent claim 1 is found to be allowed and/or allowable.

Objection to the Claims is improper

The Examiner objected to claim 1 because line 10 recites “stack” instead of “collected stack” and because lines 12-15 recite “stack” instead of “pre-collected stack”. Applicant respectfully disagrees with this basis of objection.

The feature “stack changing” in line 10 of claim 1 refers to a function step of the device for stacking an incoming sheet stream. While it is true that the collected stack is removed at a point in time after the separating table is inserted between the collected stack and the pre-collected stack, the claim is not rendered unclear simply because it recites language describing one of the functions of the device.

Furthermore, the feature “stack” in lines 12-15 is not unclear because the recited guiding devices, among other things, act to guide the stack before the stack is separated into the collected stack and the pre-collected stack.

Accordingly, the objection is believed to be improper and the Examiner is requested to withdraw this objection.

Traversal of Rejections Under 35 U.S.C. § 103(a)

Over Voss with Meschi and Deutsche

Applicant respectfully traverses the rejection of claims 1-5, 8-16 and 31-34 under 35 U.S.C. § 103(a) as unpatentable over US Patent No. 5,664,767 to VOSS in view of US Patent No. 5,292,223 to MESCHI and further in view of US Patent Application Publication No. 2002/0084578 to DEUTSCHLE et al.

Applicant also respectfully traverses the rejection of claim 37 under 35 U.S.C. § 103(a) as unpatentable over US Patent No. 5,664,767 to VOSS in view of US Patent No. 5,292,223 to MESCHI and further in view of US Patent Application Publication No. 2002/0084578 to DEUTSCHLE et al.

The Examiner acknowledges that VOSS lacks, among other things, the recited holding elements arranged on a first crossbeam and the recited movable guide arrangement which is adapted to move vertically relative to a plane of the separating table. However, the Examiner asserts that the former feature is taught by DEUTSCHLE, that the latter feature is taught in MESCHI, and that it would have been obvious to one of ordinary skill in the art to combine the teachings of these documents. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what these documents disclose or suggest, Applicant submits that no proper combination of these documents discloses or

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suggests, inter alia, a holding device for holding the pre-collected stack, the holding device comprising a first crossbeam and a plurality of holding elements arranged on the first crossbeam, a separating table adapted to receive the pre-collected stack during stack changing, a forward guiding device adapted to at least one of guide the stack and align the stack, and a rear guiding device adapted to at least one of guide the stack and align the stack, wherein the rear guiding device comprises a movable guide arrangement adapted to move vertically relative to a plane of the separating table, as recited in at least independent claim 1; and inter alia, a movable holding device comprising a first cross-member and a plurality of support elements arranged on the first cross-member, a movable separating device adapted to receive the first upper stack during stack changing, a forward guiding device adapted to guide stacking of the sheets, a rear guiding device adapted guide stacking of the sheets, the rear guiding device comprising a plurality of movable guide devices which move up and down, wherein the device is adapted to stack sheets made from at least one of paper, cardboard, foil, a flexible material, and a rigid material, as recited in at least independent claim 37.

Applicant agrees with the Examiner that VOSS does not disclose, or even suggest, the recited holding elements arranged on a first crossbeam and the recited movable guide arrangement which is adapted to move vertically relative to a plane of the separating table. However, Applicant disagrees that VOSS would benefit from the modification asserted by the Examiner. The disclosed arrangement in VOSS is apparently capable of separating a collected stack from a pre-collected stack (see Fig. 1-7 of VOSS) without being modified by

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the teachings of MESCHI and DEUTSCHLE. Thus, it is not clear that VOSS would benefit from the features asserted to be disclosed in MESCHI and DEUTSCHLE.

With regard to MESCHI, Applicant acknowledges that this document discloses a device for aligning paper sheets which utilizes vertically movable cylinder members 20 and 50. However, there is no basis for combining the teachings of MESCHI with those of VOSS at least because MESCHI merely relates to a stack aligning device for a laser printer. Furthermore, the Examiner is not correct that MESCHI discloses a rear guiding device that comprises a movable guide arrangement adapted to move vertically or up and down. First, it is clear from a fair reading of the disclosure of MESCHI that the vertical guides 20 and 50 in MESCHI are arranged on the lateral sides of the sheet stack and not a rear side the stack. Second, since VOSS merely uses a stationary rear guide wall 19 to guide the rear side of the stack and since MESCHI merely uses lateral guides to guide the lateral sides of the stack, it is clear that neither document contemplates a rear guiding device that comprises a movable guide arrangement adapted to move vertically relative to a plane of the separating table.

With regard to DEUTSCHLE, Applicant acknowledges that this document discloses what could arguably be characterized as a crossbeam 28 having a holding arrangement 42/44/48. However, Applicant submits that there is no basis for combining the teachings of DEUTSCHLE with those of VOSS. First, the Examiner is not correct that DEUTSCHLE discloses a holding device comprising a first crossbeam and a plurality of holding elements arranged on the first crossbeam or a plurality of support elements arranged on a first cross-

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member. Paragraphs [0049] and [0050] of DEUTSCHLE specifically describe portion 42 as a hollow projection having an upper panel 44 and openings 46. Thus, it is not understood how the Examiner could properly characterize such a device as a plurality of holding elements arranged on the first crossbeam or a plurality of support elements arranged on a first cross-member.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least independent claims 1 and 37. Because no proper combination of the above-noted documents discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper combination of VOSS, MESCHI and DEUTSCHLE can render unpatentable the combination of features recited in at least independent claims 1 and 37.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claims 1 and 37 is not rendered obvious by any reasonable inspection of this disclosure.

Applicant directs the Examiner's attention to the guidelines identified in M.P.E.P section 2141 which state that "[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having

the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As this section clearly indicates, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Moreover, it has been legally established that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references)."

Additionally, it has been held that a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the

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teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Furthermore, Applicant submits that dependent claims 2-5, 8-16 and 31-34 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper combination of VOSS, MESCHI and DEUTSCHLE discloses or suggests, in combination: that the device is adapted to stack sheets made from at least one of paper, cardboard, foil, a flexible material, and a rigid material as recited in claim 2; that the device is adapted to stack sheet received from a size cutter as recited in claim 3; that the sheet conveying device comprises a feed belt as recited in claim 4; that the receiver device comprises a pallet as recited in claim 5; that the movable guide arrangement is adapted to move in a direction that is generally perpendicular the plane of the separating table as recited in claim 8; that the movable guide arrangement is adapted to move vertically up and down relative to the plane of the separating table as recited in claim 9; that the movable guide arrangement comprises a plurality of spaced apart telescoping members as recited in claim 10; that the movable guide arrangement comprises a plurality of spaced apart telescoping rails as recited in claim 11; that the movable guide arrangement comprises a plurality of telescoping devices which can move in a linear direction as recited in claim 12; that each of the plurality of telescoping devices comprises an axis and wherein each of the plurality of telescoping devices moves along the axis as recited in claim 13; that each of the plurality of telescoping devices comprises a plurality of elements which slide within each other and which move

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between an extended position and a retracted position as recited in claim 14; that the movable guide arrangement comprises a plurality of devices which change in length between at least an extended position and at least a retracted position as recited in claim 15; that the movable guide arrangement comprises a plurality of devices which change in length between at least an expanded length position and at least a contracted length position as recited in claim 16; that the first crossbeam is adapted to move back and forth along a transport direction as recited in claim 31; that the transport direction is generally parallel to the plane of the separating table as recited in claim 32; that the movable guide arrangement comprises members made of a material with high rigidity as recited in claim 33; that the device comprises a modular arrangement as recited in claim 34.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

Over Voss with Meschi, Deutsche, and Williams

Applicant respectfully traverses the rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over VOSS with MESCHI and DEUTSCHLE, and further in view of US Patent No. 2,957,691 to WILLIAMS.

The Examiner acknowledges that each of VOSS, MESCHI and DEUTSCHLE lacks, among other things, the recited rear detector. However, the Examiner asserted that this feature is taught by WILLIAMS and that it would have been obvious to one of ordinary skill

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in the art to combine the teachings of these documents. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what these documents disclose or suggest, Applicant submits that no proper combination of these documents discloses or suggests, inter alia, a holding device for holding the pre-collected stack, the holding device comprising a first crossbeam and a plurality of holding elements arranged on the first crossbeam, a separating table adapted to receive the pre-collected stack during stack changing, a forward guiding device adapted to at least one of guide the stack and align the stack, and a rear guiding device adapted to at least one of guide the stack and align the stack, wherein the rear guiding device comprises a movable guide arrangement adapted to move vertically relative to a plane of the separating table, as recited in at least independent claim 1.

In addition to the forgoing discussion of VOSS, MESCHI, and DEUTSCHLE with regard to the features of independent claim 1, Applicant acknowledges that WILLIAMS discloses a sheet stacking device. However, Applicant submits that there is no basis for combining the teachings of WILLIAMS with those of VOSS, MESCHI and DEUTSCHLE. First, the Examiner has not shown how this document cures the above-noted deficiencies of VOSS, MESCHI and DEUTSCHLE. Second, the Examiner is not correct that WILLIAMS discloses a rear detector. Fig. 1 of WILLIAMS clearly shows that the asserted device 60 is arranged at a front or forward position of the stack. As a result, the Examiner cannot properly characterize device 60 as a rear detector. Third, col. 5, lines 20-31 of WILLIAMS

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describes device 60 as a front sheet jogging device and not a detector. As a result, the Examiner cannot properly characterize device 60 as a rear detector. Thus, it is not understood how the Examiner could properly characterize such a device as a rear detector that is part of the rear guiding device.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least independent claim 1, or claim 6. Because no proper combination of the above-noted documents discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper combination of VOSS, MESCHI, DEUTSCHLE, and WILLIAMS can render unpatentable the combination of features recited in at least independent claim 1, and dependent claim 6.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection of this disclosure.

Furthermore, Applicant submits that dependent claim 6 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention. In particular, Applicant submits that no proper combination of VOSS, MESCHI, DEUTSCHLE, and WILLIAMS discloses or suggests, in combination: that the forward guiding device comprises a forward

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front stop and wherein the rear guiding device comprises a rear detector as recited in claim 6.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

Over Voss with Meschi, Deutsche, and Thornton

Applicant respectfully traverses the rejection of claims 17-28 under 35 U.S.C. § 103(a) as unpatentable over VOSS with MESCHI and DEUTSCHLE, and further in view of US Patent No. 4,162,649 to THORNTON.

Applicant also respectfully traverses the rejection of claim 38 under 35 U.S.C. § 103(a) as unpatentable over VOSS with MESCHI and DEUTSCHLE, and further in view of US Patent No. 4,162,649 to THORNTON.

The Examiner acknowledges that each of VOSS, MESCHI and DEUTSCHLE lacks, among other things, the recited second crossbeam. However, the Examiner asserted that this feature is taught by THORNTON and that it would have been obvious to one of ordinary skill in the art to combine the teachings of these documents. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what these documents disclose or suggest, Applicant submits that no proper combination of these documents discloses or suggests, inter alia, a holding device for holding the pre-collected stack, the holding device

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comprising a first crossbeam and a plurality of holding elements arranged on the first crossbeam, a separating table adapted to receive the pre-collected stack during stack changing, a forward guiding device adapted to at least one of guide the stack and align the stack, and a rear guiding device adapted to at least one of guide the stack and align the stack, wherein the rear guiding device comprises a movable guide arrangement adapted to move vertically relative to a plane of the separating table, as recited in at least independent claim 1; and inter alia, a movable first cross-member and a plurality of support elements arranged on the first cross-member, the movable first cross-member and a plurality of support elements being movable towards and away from stacked sheets and being movable up and down, a non-movable second cross-member, a movable separating device adapted to receive the first upper stack during stack changing, a forward guiding device adapted to guide stacking of the sheets, a rear guiding device adapted guide stacking of the sheets, the rear guiding device comprising a plurality of movable guide devices which move up and down, and each of the plurality of movable guide devices comprising one end connected to the first cross-member and another end connected to the second cross-member, wherein the device is adapted to stack sheets made from at least one of paper, cardboard, foil, a flexible material, and a rigid material, as recited in independent claim 38.

Furthermore, in addition to the forgoing discussion of VOSS, MESCHI, and DEUTSCHLE with regard to the features of independent claim 1, Applicant acknowledges that THORNTON discloses a sheet stack divider. However, Applicant submits that there is

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no basis for combining the teachings of THORNTON with those of VOSS, MESCHI and DEUTSCHLE. First, the Examiner has not shown how this document cures the above-noted deficiencies of VOSS, MESCHI and DEUTSCHLE. Second, the Examiner is simply not correct that THORNTON discloses the recited second crossbeam arranged in a region of the sheet conveying device or that device 60 is connected to one end of each of the plurality of movable guide devices. For example, Fig. 7 of THORNTON clearly shows that the asserted device 53 is arranged at a front or forward position of the stack and not near the sheet conveying device 2. As a result, the Examiner cannot properly characterize device 53 as being arranged in a region of the sheet conveying device.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least independent claims 1 and 37, or dependent claims 17-28. Because no proper combination of the above-noted documents discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper combination of VOSS, MESCHI, DEUTSCHLE, and THORNTON can render unpatentable the combination of features recited in at least independent claims 1 and 37, or dependent claims 7-28.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claims 1

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and 37 is not rendered obvious by any reasonable inspection of this disclosure.

Furthermore, Applicant submits that dependent claims 17-28 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper combination of VOSS, MESCHI, DEUTSCHLE, and THORNTON discloses or suggests, in combination: that the device further comprises a second crossbeam arranged in a region of the sheet conveying device as recited in claim 17; that the movable guide arrangement comprises a plurality of length changing devices as recited in claim 18; that each of the plurality of length changing devices comprise an end which is at least one of connected to and attached to the second crossbeam as recited in claim 19; that each of the plurality of length changing devices comprise another end which is at least one of connected to and attached to the first crossbeam as recited in claim 20; that each of the plurality of length changing devices comprises a telescoping device which can move in a linear direction as recited in claim 21; that each telescoping device comprises a telescoping rail as recited in claim 22; that wherein each telescoping device comprises elements which moved in and out of each other in a vertical direction relative to the plane of the separating table as recited in claim 23; that each telescoping device comprises elements which move in and out of each other in a vertical direction relative to the plane of the separating table and which can move with movement of the first crossbeam as recited in claim 24; that each telescoping device comprises elements which move in and out of each other upon movement of the first crossbeam as recited in claim 25; that each telescoping device is attached firmly to the second crossbeam and is

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adapted to move with the first crossbeam as recited in claim 26; that the first crossbeam is adapted to move back and forth along a transport direction as recited in claim 27; and that the transport direction is generally parallel to the plane of the separating table as recited in claim 28.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

Acknowledgment of Allowable Subject Matter

Applicant acknowledges and appreciates the Examiner's indication that claims 29 and 30 are allowed. However, as these claims are not presented in independent form, Applicant assumes that the Examiner intended to instead indicate that these claims contain allowable subject matter and would be allowable if written in independent form. At this time, however, Applicant is not presenting these claims in independent form.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

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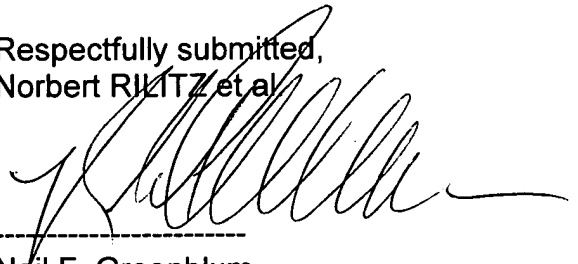
Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Authorization is hereby given to refund excess payments and charge any additional fee necessary to have this paper entered to Deposit Account No. 19-0089.

Should there be any questions, the Examiner is invited to contact the undersigned attorney at the number listed below.

April 6, 2006
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